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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,311	05/11/2006	Shozaburo Konishi	KAN-067 (10530)	5058
63479 7590 11/08/2010 HAHN & VOIGHT PLLC 1012 14TH STREET, NW SUITE 620 WASHINGTON, DC 20005				
EXAMINER				
VASISTH, VISHAL V				
ART UNIT		PAPER NUMBER		
1771				
MAIL DATE		DELIVERY MODE		
11/08/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,311

Applicant(s)

KONISHI ET AL.

Examiner

VISHAL VASISTH

Art Unit

1771

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2,5-8 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicants' response filed on 8/18/2010 amended independent claim 1 and dependent claim 8. Neither applicants' arguments addressed below nor amendments overcome the 35 USC 103 rejection over Miyake in view of Yagishita from the office action mailed on 5/18/2010 and therefore this rejection is maintained below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-2, 5-8 and 18-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al., JP Publication No. 2001-316686 (hereinafter referred to as Miyake) in view of Yagishita, US Patent Application Publication No. 2005/0272616 (hereinafter referred to as Yagishita).

Miyake discloses a lubricant and a system having a pair of DLC contacting faces being opposed to each other and moving relative to one another, wherein at least one of which is coated with a DLC film (as recited in claims 1 and 8) and is suitably used in lubricating oils such as an engine and transmission oil (as recited in claims 1 and 6) (Para. [0001]).

The sliding members have a lubricant interposed between them used to lubricate the sliding members (as recited in claims 1 and 8) wherein the lubricant is a mineral or synthetic base oil (base oil as recited in claims 1 and 8) and has additives including molybdenum dithiocarbamate (sulfur-containing molybdenum complex as recited in claims 1, 8, 20 and 25) with a concentration of 0.01-0.2 wt% of molybdenum (within the range as recited in claims 23 and 28) and zinc dithiophosphate in a concentration as to add 50-1000 ppm phosphorus to the lubricating oil (phosphorus-based anti-wear agent as recited in claims 2, 10 and 18 and overlaps the range as recited in claims 24 and 29) (Para. [0020]).

The composition of Miyake does not explicitly disclose non-DLC contact surfaces having no DLC film wherein said lubricant is interposed between the non-DLC contact surfaces as recited in claim 7. The examiner is of the position that one of ordinary level of skill in the art would envisage using the same lubricant composition in an internal combustion engine for parts that are non-DLC containing contact surfaces.

Miyake as discussed above discloses the presence of a mineral or synthetic base oil to be used in combination with a DLC coating. Miyake does not, however, explicitly disclose a base oil wherein at least one of a hydrocracked mineral oil, a wax-

isomerized mineral oil, and a poly-alpha-olefin base oil, and has a kinematic viscosity of 2 to 20 mm²/s at 100°C, a total aromatic content of not higher than 5 mass %, and a total sulfur content of not higher than 0.005 mass %. Miyake also does not disclose a friction modifier and a metal detergent.

Yagishita discloses a lubricant composition for use in an internal combustion engine comprising a base oil derived from hydrocracking and produced by isomerizing GTL wax (as recited in claims 1 and 8) (Para. [0020]) wherein the hydrocracked base oil has a kinematic viscosity of 10 mm²/s or less (which overlaps the kinematic viscosity range as recited in claims 1 and 8) (Para. [0025]), has a total aromatics content of 2 mass% or less (within and encompassing the aromatics range as recited in claims 1 and 8) (Para. [0024]) and a total sulfur content of 0.1 mass% or less (within and encompassing the sulfur content range as recited in claims 1, 5, 8 and 19) (see Abstract).

The fully formulated composition of Yagishita further comprises additives including neutral alkaline earth metal salicylates in a concentration of 0.005 to 5% by mass of the total of the composition, and the amount being an amount in terms of the metal element therein (a sulfur-free, neutral metal detergent as recited in claims 1 and 8 and overlaps the range as recited in claims 23 and 28) (Para. [0028], [0048] and see Abstract), 0.005 to 5 wt% of a friction modifier including aliphatic acid esters, aliphatic amines, aliphatic acid amides and aliphatic ethers (as recited in claims 1, 8 and 21 and overlaps the range as recited in claims 23 and 28) (Para. [0061] and [0070]) and anti-

wear additives including metal phosphates (sulfur-free phosphorus anti-wear compound as recited in claims 2, 10 and 17).

Yagishita discloses aliphatic acid ester friction modifiers, but does not explicitly disclose glycerol monooleate being the specific aliphatic acid ester friction modifier. It is the position of the examiner that one of ordinary skill in the art would immediately envisage glycerol monooleate from the disclosure of Yagishita and that glycerol monooleate would be obvious to try as a friction modifier in the composition.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the base oil and additives of Yagishita in the composition of Miyake because all the additives are very well known in the art and would conventionally be used to enhance friction, detergency and anti-wear properties in the composition.

Response to Arguments

5. Applicants' arguments filed on 8/18/2010 with respect to claims 1-2, 5-8 and 18-29 have been fully considered and are not persuasive.

Applicants argued that Miyake teaches away from the instantly recited claims 1 and 8 by limiting the DLC film coating to amorphous and hydrogenated amorphous carbon coatings. This argument is not persuasive. Miyake, in paragraph 16 and in Claim 4, it is clearly stated that one of the sliding members is an amorphous carbon film wherein a concentration of metal is present. Based on current claim language being "comprising of" the claim is open-ended and additional components may be present in either the DLC contact surfaces or the lubricant composition.

Applicants also argued that the present invention provides unexpected results and point to the data in Table 1 of the instant specification to support their position. Applicants did compare their example oils to the closest prior art, but the data is not commensurate with the scope of the claims, including the newly added claims. Even if the newly added claims are commensurate in scope, the independent claims from which they depend are not. For example, the additives blended with the base oil to formulate the finished composition are in very specific concentrations and are very specific compounds. For instance in base oil 1, the friction modifiers are glycerin monooleate. Claim 1 merely recites a sulfur-containing molybdenum complex and does not include any of the other additives or any of their respective concentrations. Therefore, the arguments are not persuasive to show unexpected results. Also, in order to demonstrate unexpected results the criticality of the ranges need to be shown and compared to the closest prior art. Applicants did narrow the base oils in a manner that demonstrates unexpected results but none of the additives were narrowed in the same manner and the additive compounds were not limited.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV
/Ellen M McAvoy/
Primary Examiner, Art Unit 1771